

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111 and in light of the remarks which follow, are respectfully requested.

By the above amendments, each of claims 9 and 24 has been amended for clarification to be directed to an aqueous lubricant comprising an aqueous liquid and at least one compound. Support for this amendment can be found in the instant specification at least at pages 3-8. Claims 9 and 24 have also been amended for readability purposes by deleting the objected-to term “comprising”, and to recite the phrase “said compound having the following structure”. Claim 24 has further been amended for clarification purposes to recite the phrase “at least one condensed phosphate and/or polyoxy carboxylic acid coordinated with the metal”. Claims 10, 25 and 28-38, 40 and 47-49 have been amended for readability purposes consistent with the above amendments of claims 9 and 24. Claim 48 has also been amended to correct the spelling of “tripolyphosphate”.

In the Official Action, claims 9-38 and 40-49 stand rejected under 35 U.S.C. §112, second paragraph, for the reasons discussed at page 2 thereof. Without addressing the propriety of this rejection, and in an effort to expedite prosecution, the objected-to term “comprising” has been deleted from claims 9 and 24 for readability purposes. For at least this reason, withdrawal of the above rejection is respectfully requested.

Claims 9 and 24 stand rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,385,954 (*Palazzotto et al*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Palazzotto et al does not disclose or suggest each feature of aspects of the present invention as defined by claims 9 and 24. For example, *Palazzotto et al* does not disclose or suggest an aqueous lubricant comprising an aqueous liquid and at least one compound having the structure recited in claims 9 and 24. In stark contrast, *Palazzotto et al* relates to the polymerization of cationically-sensitive materials employing as polymerization initiator a certain class of ionic organometallic compounds (col. 1, lines 12-15). *Palazzotto et al* simply has no recognition or suggestion of an aqueous lubricant, let alone including the disclosed ionic organometallic compound in an aqueous lubricant.

For at least the above reasons, *Palazzotto et al* fails to anticipate or render obvious aspects of the present invention as defined by claims 9 and 24. Accordingly, withdrawal of the rejection based on *Palazzotto et al* is respectfully requested.

Claims 9-38 and 40-49 stand rejected 35 U.S.C. §103(a) as being obvious over *Palazzotto et al* combined with Japanese Patent Document No. 118283/1995 (*JP '283*) and U.S. Patent No. 4,151,099 (*Nassry et al*) in view of U.S. Patent No. 3,249,538 (*Freier*), U.S. Patent No. 4,654,155 (*Kipp et al*), Japanese Patent Document No. 04239096 (*JP '096*) and Tribology in Metalworking, 1983 (*Schey*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

It is well established that in order to support a *prima facie* case of obviousness, the Patent Office must show that there is some suggestion or motivation to modify a reference or combine reference teachings. M.P.E.P. §2143.01 states that “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so.”

In the present case, it is apparent that absent an improper resort to Applicants' own disclosure, one of ordinary skill in the art would not have been motivated to combine

Palazzotto et al with the above secondary applied documents in the manner suggested by the Patent Office. In support of its alleged combination, the Patent Office has stated the following at pages 5 and 6 of the Official Action:

It is the examiner's position that it would have been obvious to one of ordinary skill in the art with the combined teachings of *Palazzotto*, *Tonen* and *Nassry* to produce an aqueous metal lubricant composition with metal compounds and to use the said aqueous composition with metal compounds. And to further use the said aqueous composition to coat or lubricant [sic] a metal surface because combining two or more materials disclosed by the prior art for the same purpose to form a third material that is to be used for the same purpose has been held to be a *prima facie* case of obviousness [emphasis added] . . .

However, contrary to the Examiner's position, *Palazzotto et al* does not disclose a material that is "for the same purpose" as the materials disclosed by the secondary applied documents which are relied upon by the Patent Office. As discussed above, *Palazzotto et al* relates to polymerizable compositions containing cationically-sensitive materials and organometallic complex materials. By comparison, each of the secondary applied documents relates to the use or production of lubricants.¹ For at least this reason, it is apparent that the Patent Office's cited motivation to combine *Palazzotto et al* with the secondary applied documents is unfounded.

Moreover, in light of the fact that none of the applied documents provide any guidance or suggestion for using the compounds disclosed in *Palazzotto et al* in an aqueous lubricant, it is clear that no *prima facie* case of obviousness exists. Accordingly, withdrawal of the above §103(a) rejection is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

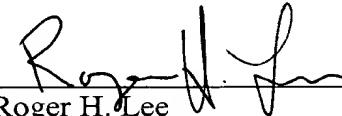
¹ See, e.g., *JP '283* at page 1, last two lines; *Nassry et al* at title and abstract; *Freier* at title and col. 1, lines 18-22; *Kipp et al* at title and abstract; *JP '096* at abstract; and *Schey* at title.

If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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